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**TO:** Examiner E. Cherry  
Group Art Unit 2872

**FROM:** Michael K. O'Neill

**RE:** U.S. Application No: 10/624,544  
Atty. Docket No.: 03500.016090.1

**FAX NO.:** (703) 872-9306

**DATE:** May 19, 2005 **NO. OF PAGES:** 3  
(including cover page)

**TIME:** 3:18 **SENT BY:** *[Signature]*

**MESSAGE**

2005 Attached is a Response to the Election of Species Requirement dated April 19,

I hereby certify that this correspondence is being facsimile transmitted to  
the U.S. Patent and Trademark Office on:

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03500.016090.1

PATENT APPLICATION

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
: Examiner: E. Cherry  
HIDEKAZU SHIMOMURA )  
: Group Art Unit: 2872  
Application No.: 10/624,544 )  
: Filed July 23, 2003 )  
: For: OPTICAL SCANNING )  
: APPARATUS AND IMAGE )  
: FORMING APPARATUS )  
: USING THE SAME ) May 19, 2005

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Sir:

In response to the April 19, 2005 Requirement To Elect between species,  
Applicants hereby provisionally elect to prosecute Species 2, namely Claims 37 to 46.

The requirement is respectfully traversed.

Traversal is on the grounds that the PTO has not established any of the  
factual predicates needed to impose such a requirement. In particular, since this is a  
requirement to elect between species, and since species are always specifically different

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embodiments of the invention, the PTO was required to identify the specifically different embodiments described in the specification. This was not done. Rather, the PTO equated different species to different claims, which is not permitted. See MPEP § 806.04(e):

*"Claims are definitions of inventions..Claims are never species. Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a *generic or genus claim*).*

*"Species are always the specifically different embodiments."*  
(Emphasis in original)

Thus, the requirement to elect is faulty and should be withdrawn.

Applicant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



Attorney for Applicant  
Michael K. O'Neill  
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